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SIOW CHIANG & CO PTE LTD

v.

TAN GIN LEE

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HIGH COURT MALAYA, SHAH ALAM
SURIYADI HALIM OMAR J
[CIVIL SUIT NO: MT1-22-255-2004]
23 JUNE 2005

C ***CIVIL PROCEDURE:*** *Injunction - Interlocutory injunction restraining passing off of goods - Whether sufficiently established*

TRADE MARKS: *Passing off - Similarity in trade names - Whether ordinary public will be misled into thinking that one's goods or services are those of another business - Likelihood of deceit - Whether ordinary public will be*
D *deceived where there is vast dissimilarity between two opposing products*

TRADE MARKS: *Passing off - Deception or confusion - Whether needing only to prove misrepresentation but not confusion - Whether a small differentiation will suffice to defeat plaintiff's claim of passing off*

E ***TRADE MARKS:*** *Passing off - Trade mark descriptive of product - Whether the name "Sure Catch" a descriptive name - Whether acquired a secondary meaning deserving protection*

The plaintiff, a company registered in Singapore, produced and
F distributed equipments and accessories connected to fishing carrying the catchy word "SureCatch" extensively to several countries around the world. The word had been extensively used in Singapore and Malaysia since 1991, and was registered in Singapore. The defendant sold and distributed various fishing equipments in Malaysia. The plaintiff discovered that the defendant was selling products of an identical or
G similar nature or description, and with the fancy words similar with the plaintiff's catchy word. The plaintiff filed an action claiming a permanent and interlocutory injunction restraining the defendant from passing-off fishing equipment with identical or similar description similar to the catchy word of "SureCatch".

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The evidence showed that the plaintiff's products carried the word "SureCatch" followed by the utility item *eg*, "SureCatch Tackle Box, SureCatch Telescopic Rod, and SureCatch Leather Rod Bag etc." The plaintiff's packaging was also attractive having red, fading orange and
I deep sea blue colours; a caricature of a curling huge merlin (fish) leaping out into the air from the sea splashed on each packet; a colourless catchy word of "SureCatch" imprinted and dominating every packet. The

packaging was of quality and sophistication and stated the source as Singapore. The infringing items sold by the defendant was contained in green packets which were one third the size of the plaintiff's products. These green packets were stapled to cheap plastic containers, which contained the fishing items. The defendant's packaging featured a darkened eagle flying with wings widely spread apart, lifting a fish imprisoned in its talons and having as its background an orange coloured moon. At the unobtrusive bottom border were the words "SURE CATCH", darker and smaller in size compared to the plaintiff's catchy words. The infringing items had the price tag together with the address of the defendants in Klang, Selangor.

Held (disallowing injunction):

(1) The prospective customer must be taken as they are found, with there being no principle of law that customers must be literate, careful or even streetwise. The prospective customer therefore will be an ordinary purchaser purchasing with ordinary caution and possessing an ordinary memory. (para 10)

(2) 'Passing off' is the conducting of one's business in such a way as to mislead the ordinary public into thinking that one's goods or services are those of another business. The judge is under a duty to place himself in the position of that ordinary potential purchaser and visually make comparisons and thereafter conclude the likelihood of deceit. (paras 11 & 12)

(3) It could not be said that the ordinary public will be deceived into thinking that the defendant's products were the plaintiff's products. The discerning buyer certainly will not be deceived due to the obvious vast dissimilarity between the two opposing products, which even a non-discerning person, cannot but notice. (para 17)

(4) Courts have required the ingredient of misrepresentation, aside from the other ingredients, but never extending it to confusion. To acquiesce to the plaintiff's suggestion that passing off has been established, merely because of some customer having suffered confusion by the catchy word, is extending unnecessarily the common-law right of action. (para 25)

(5) The words SURE CATCH had not acquired a secondary meaning deserving protection. (para 26)

A **(6)** In the absence of fraud, where descriptive words are used in a trade name, a small differentiation will suffice to defeat a plaintiff's claim of passing off. A passing off had not been successfully established by the plaintiff. With such a failure, the injunction application had to be rejected too. (paras 28, 34 & 38)

B **Case(s) referred to:**
AG Spalding & Bros v. AW Gamage Ltd [1915] 32 RPC 273 ***(refd)***
American Cynamid Co v. Ethicon Ltd [1975] AC 396 ***(refd)***
Boh Plantations Sdn Bhd v. Gui Nee Chuan & Ors [1975] 2 MLJ 213 ***(refd)***
Colgate Palmolive Ltd & Another v. Pattron [1978] RPC 635 ***(refd)***
C *Erven Warnink Besloten Vennootschap & Ors v. Townend & Son (Hall) Ltd & Ors [1979] AC 731* ***(refd)***
H & R Johnson Tiles Ltd & Anor v. H&R Johnson (M) Bhd [1998] 3 CLJ Supp 441 HC ***(refd)***
Keet Gerald Francis Noel John v. Mohd Noor Abdullah [1995] 1 CLJ 293 CA ***(refd)***
D *Office Cleaning Services Ltd v. Westminster Window and General Cleaners Ltd [1946] Vol 174 LT 229* ***(refd)***
Reckitt & Colman Products v. Borden [1990] 1 All ER 873 ***(refd)***
Seet Chuan Seng & Anor v. Tee Yih Jia Foods Manufacturing Pte Ltd [1994] 3 CLJ 7 SC ***(refd)***
Seixo v. Provezenoe [1865] LR 1 Ch 192/196 ***(refd)***
E *White Hudson & Co v. Asian Organisation Ltd [1965] 31 MLJ 186* ***(refd)***

Legislation referred to:
Trade Marks Act 1976, s. 38

Other source(s) referred:
F Christopher Wadlow, *The Law of Passing-off,* 2nd edn, p 383
Cross *Reports of Patent, Design and Trade Mark Cases* [1960] No 6, p 147

For the plaintiff - Kenneth James; M/s Michael Chai & Co
For the defendant - YY Ho; M/s YY Ho & Assocs

G *Reported by Amutha Suppayah*

JUDGMENT

Suriyadi Halim Omar J:

H **[1]** The plaintiff is a company registered in Singapore and has been, amongst others, producing and distributing its products carrying the catchy word "SureCatch" (hereinafter may be referred to interchangeably as the plaintiff's fanciful catchy word or the plaintiff's products) extensively to several countries around the world. The products concerned pertained to equipments and accessories connected to fishing.
I The said catchy word has been extensively used in Singapore since 1991, and was registered in Singapore on 30 August 1999, with it still

valid and subsisting to-date. Without the necessity of a dissertation, suffice if I state that the plaintiff's trade mark being registered in Singapore is irrelevant in Malaysia. Aside from that, an action for an infringement of a trade mark differs from an action of passing off, the very legal principle under scrutiny before me. Even though a trademark application was made in Malaysia on 29 February 2000, that catchy word has been in extensive use in Malaysia by the plaintiff since 1991.

[2] The defendant on the other hand is a sole proprietor, carrying on business in the sale and distribution of various fishing equipments at Klang, Selangor, Malaysia. With the passing of time the plaintiff discovered that the defendant had distributed, sold and offered for sale products of an identical or similar nature or description, and with a fancy word or words similar or almost identical with the plaintiff's catchy word, at the said defendant's retail outlet in Malaysia without permission or approval. The alleged misrepresentation, and an actionable wrong in common-law, having been committed by the defendant is normally referred to as passing off, is still on-going.

[3] With the plaintiff being naturally upset, as its interest and rights had been invaded, resulting in alleged losses, certain litigations were thereupon launched. In response to that invasion of rights, the plaintiff on 31 March 2004 had filed a writ together with a statement of claim, praying, amongst others a permanent injunction restraining the defendant, whether acting by himself, his servants or agents or any of them, or otherwise howsoever from passing-off fishing equipment, including fishing hooks with identical or similar description similar to the catchy word of "SureCatch". In a nutshell the plaintiff prays that the defendant be injuncted from continuing the breach.

[4] On the very same day the writ of summons and statement of claim were filed, the plaintiff had simultaneously filed a summons in chamber (encl. 4), praying for an interim injunction, pending the disposal of the abovementioned writ and statement of claim. Similar in content to the writ and statement of claim, the plaintiff had also prayed that the defendant be stopped from passing off, *inter alia* producing, manufacturing, marketing, distributing for the purpose of sale, selling, stocking or supplying for the purpose of sale any offending products, or cause, aid or assist or enabling others to commit any of the abovementioned acts.

[5] The contents of the supporting affidavit of the summons in chambers were certainly no different in content to the statement of claim, with all the above supplied facts equally found in it. It affirmed that the products of the plaintiff carried the word "SureCatch" followed by the

utility item eg, "SureCatch Tackle Box, SureCatch Telescopic Rod, and SureCatch Leather Rod Bag etc." In brief, any item for sale used in any fishing outing will carry that word. The plaintiff's officer also affirmed that it had spent a substantial sum of money to advertise, promote and market its product whereupon the plaintiff had successfully obtained recognition of the products in Malaysia. By September 2003, the plaintiff's total yearly sales in Malaysia had grossed about RM3 million.

[6] According to the plaintiff, the distribution and sale of the offending products which carried the fanciful words by the defendant without consent of the plaintiff, was an act calculated to deceive, misrepresent and or cause confusion to the public. It was to create a belief in the market that the plaintiff was the source of the offending products. The unauthorized acts had caused actual damage or injury to the plaintiff's business, reputation and or goodwill. The purpose of the interim injunction applied for was merely to prevent the defendant from continuing to produce, sell and distribute the offending products and cause further damage and losses to the plaintiff.

[7] No less than five different packets of the plaintiff's products, but without the items for sale contained in them, were supplied to me for inspection, primarily for purposes of identification, and giving me an idea of its products. I saw:

1. attractive packets having red, fading orange and deep sea blue colours;
2. a caricature of a curling huge merlin (fish) leaping out into the air from the sea splashed on each packet;
3. a colourless conjoined and grammatically incorrect but catchy word of "SureCatch" imprinted and dominating every packet;
4. quality and sophisticated paper wrappings; and
5. some packets carrying the design and engineering source ie, Singapore.

[8] The plaintiff also supplied me with the infringing items sold by the defendant and I saw:

1. only green packets which were one third the size of the plaintiff's products;
2. these green packets were stapled to cheap plastic containers, which contained the fishing items;

3. a darkened eagle flying with wings widely spread apart lifting a fish imprisoned in its talons;

4. this silhouetted darkened eagle had as its background an orange coloured moon;

5. at the unobtrusive bottom border were the words "Sure Catch" (any products carrying these two words will hereinafter be referred to as the offending products) followed by the items eg, "Sure Catch Tackle", with the words 'Sure Catch' not joined like 'SureCatch');

6. the words eg, Sure Catch Tackle were darkened and smaller in size compared to the plaintiff's catchy words; and

7. the infringing items had the price tag together with the address of the defendants in Klang, Selangor.

[9] Without the necessity of a minute perusal of both the plaintiff's and defendant's products, but just by mere sight and without the assistance of any expert, the following are my eventual findings, beginning with the defendant's:

Defendant's Products

1. the top portion gives the appearance of being cheap;

2. the colour is distinctive but not attractive;

3. the words of Sure Catch are not dominant;

4. the materials to pack the items sold are of poor quality;

5. attention is meant to focus on the eagle and the encircled orange coloured background rather than the words;

6. in fact any customer will not be taken in by the words; and

7. the words are generic and certainly not unique.

Plaintiff's Products

1. appears to be sophisticated;

2. the appearance of it being imported goods is beyond doubt;

3. the word SureCatch is catchy, strategically positioned and dominating;

4. any buyer will immediately know that the words SureCatch is the attention catcher of the goods and not any other markings;

A 5. the other markings are near invisible; and

6. the conjoined words, which are grammatically incorrect but catchy and serving a second purpose, gives that unique quality to it.

B **[10]** The principle for disallowing passing off is based on the concept of right and wrong. It is certainly not right and definitely deceitful, for any trader in the course of trade to misrepresent to prospective customers of his goods or services, which will foreseeably injure the business or goodwill of another trader, causing actual damage to that trader. That prospective customer must be taken as they are found, with C there being no principle of law that customers must be literate, careful or even streetwise. The prospective customer therefore will be an ordinary purchaser purchasing with ordinary caution and possessing an ordinary memory *(Seixo v. Prouezenoe* [1865] LR 1 Ch 192/196; *Colgate Palmolive Ltd and Another v. Pattron* [1978] RPC 635*)*.

D **[11]** In a nutshell 'passing off may be defined as the conducting of one's business in such a way as to mislead the ordinary public into thinking that one's goods or services are those of another business. The commonest form of passing off is by marketing goods with a design, packaging, or trade name that is very similar to that of someone E else's goods *(Erven Warnink Besloten Vennootschap & Ors v. Townend & Son (Hull) Ltd & Ors* [1979] AC 731; *Oxford Dictionary of Law)*. Here the plaintiff has alleged that the defendant is transacting fishing items carrying the words "Sure Catch" and misleading the public into thinking that the products sold by the defendant are those of the plaintiff's F "SureCatch" products. In a word, the plaintiffs case totally depended on the two words of "Sure Catch" only, and not on any other parts of the defendant's products get up.

[12] Needless to say if there are obvious similarities, say, in the G name of the company and the products, courts will not hesitate to pronounce that there is passing off by the offender. The difficult part comes when the similarities are not so obvious, hence putting the judge in the unenviable position of reflecting how that 'ordinary purchaser with ordinary caution and ordinary memory' will react. Already in the circumstances of the case, as there is absence of any cogent evidence H of any ordinary purchaser having been deceived, evidentially the plaintiff is in an awkward predicament. Returning to that abovementioned hypothetical judge, he is therefore under a duty to place himself in the position of that ordinary potential purchaser and visually make comparisons and thereafter conclude the likelihood of deceit.

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[13] In *Seet Chuan Seng* & *Anor v. Tee Yih Jia Foods Manufacturing Pte Ltd* [1994] 3 CLJ 7 SC the first appellant and a few others had launched a successful popiah skin business in Singapore under the respondent's name. The latter subsequently left the respondent company and set up a business in Malaysia and started a limited company using the trade name Tee Yin Jia Popiah Dried Pastry Factory (M) Sdn Bhd. This Malaysian company even used a logo similar to that used by the respondent ie, a swastika appearing at the left-hand corner of the get-up. The High Court concluded that a passing off had occurred with the use of:

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i. the trade name of Tee Yih Jia;

ii. a package get up so identical to or closely resembling the respondent's package get up; and

iii. the swastika logo's presence.

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[14] The matter went up before the Supreme Court on appeal but was dismissed. The apex appeal court had opined, after having scrutinized the evidence that, the name 'Tee Yih Jia', the swastika logo, and get up (consist simply of the brand name, trade description or the individual features of labeling or packaging) had become distinctive of the respondent's products. The appellant's usage of those distinctive features was likely to deceive or cause deception to a potential buyer or customer of popiah skins. In a word no judge will have any difficulty in arriving at the conclusion that a passing off had taken place.

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[15] The only near similarity between the plaintiff's and defendant's products are the alphabets making up Sure Catch and SureCatch. The plaintiff's singular word is conjoined and grammatically incorrect hence catchy whilst the defendant's not so attractive but grammatically correct. The plaintiff's attention seeking word is parked smack in the middle of the packet blazing away with that imaginative word. The defendant's words, which are a poor cousin to that of the plaintiff's word, are descriptive in nature, and handicapped by its want of strategic positioning or emblazoned size.

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[16] Despite my unfavourable finding, which militates against the interest of the plaintiff, it cannot be denied that there indeed exists a slight possibility that an innocent buyer can still be confused by the defendant's fanciful words (call it by whatever name). On the other hand, it is essential that to qualify as a serious question, as to whether a passing-off has taken place, over-dependency being placed upon some ineffective and minimal evidential similarity will not suffice. In the above case of *Seet Chuan Seng v. Tee Yih Jia (supra)* the resemblance was very

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conspicuous as opposed to the current case (see Cross in *New Way Packaged Products Ltd v. Lucking (S) Ltd (Reports of Patent, Design and Trade Mark Cases)* [1960] No. 6 at p. 147 dated 27 July 1960).

[17] Returning to the facts of this case if not for the phrase Sure Catch, let alone it is not positioned at a strategic place there is nothing else that can be said to bring it within a valid cause of action of passing off. It is too close to call, to confidently state that after having seen the defendant's products the ordinary public will be deceived into thinking that they are the plaintiff's products. The discerning buyer certainly will not be deceived not because of his discerning taste and thus capable of differentiating the products, but due to the obvious vast dissimilarity between the two opposing products, which even a non-discerning person, cannot but notice.

[18] For the uninitiated and ordinary public, as opposed to the above discerning customer, invariably he is at the outlet only to buy fishing items, and cares not about brands, trade marks or catchy words. More often than not the scenario for the ordinary and undiscerning customer will appear thus: He will pick up the items he wants without giving much thought to the brand, or he will announce that he desires to buy, say, a fishing hook but without specifying the trade mark eg, SureCatch. He will then be assisted, whereupon he is given the item carrying the words Sure Catch, and without batting any eye promptly purchases it.

[19] Misrepresentation cannot be said to have played a part in the above hypothetical purchase as he has bought it due to some confusion caused by his own generalized request. In such a scenario surely the prerequisites of passing off cannot be said to exist and its accusation must be rejected *(Reckitt & Colman Products v. Borden* [1990] 1 All ER 873). In fact if he is no connoisseur of brands the issue of confusion does not even arise. He will not even bother as to the brand he wants, or the item he has bought so long as it is a fishing hook. To him a hook is still a hook call it by whatever name.

[20] Some mention must be made as regards the *ingredient of confusion,* which has been bandied around by the plaintiff in the course of the hearing, heavily sprinkled also in parts of its submission. I do not deny the existence of this ingredient under s. 38 *o*f the Trade Marks Act 1976 (Act 175) which reads:

> (1) A registered trade mark is infringed by a person who, not being a registered proprietor of the trade mark or registered user of the trade mark using by way of permitted use, uses a mark which is identical with it or so nearly resembling it as is likely to deceive or cause confusion in the course of trade in relation to goods or service in respect of which the trade mark is registered in such a manner ...

[21] It is quite cut and dry that the above provision enacts within it the terminology of confusion. In brief an infringement occurs if a person who, not being a registered proprietor of the trademark, *inter alia* uses a mark which is identical with it or so nearly resembling it as, amongst others, is likely to *cause confusion* in the course of trade.

[22] As opposed to this, in *Seet Chuan Seng & Anor v. Tee Yih Jia Foods Manufacturing Pte Ltd (supra)* at *holding 1,* is written the following:

> In order to create a valid cause of action for passing off, there must be **misrepresentation** made by a trader in the course of trade to prospective customers of his or ultimate consumers of goods or services supplied by him, which was calculated to injure the business or goodwill of another trader and which caused actual damage to a business or goodwill by whom the action is brought ... (emphasis added).

[23] In *AG Spalding & Bros v. A.W Gamage Ltd* [1915] 32 RPC 273 Lord Parker of Waddington in the House of Lords had said:

> My Lords the basis of a passing off action being a false representation by the defendant, must be proved in each case as a fact that the false representation was made. It may of course, have been made in express words, but cases of express of misrepresentation of this sort is rare. The more common case is where the representation is implied in the use of imitation of a mark, trade name, or get up with which the goods of another are associated in the minds of the public ... In such cases the point to be decided is whether having regard to all the circumstances of the case the use by the defendant in connection with the goods of the mark, name or get up in question impliedly represents such goods to be the goods of the plaintiff, or the goods of the plaintiff of a particular class or quality. Or, as it is sometimes put, whether the defendant's use of such mark, name, or get-up is **calculated to deceive** (emphasis added).

[24] In *Reckitt & Colman Products Ltd v. Borden In and Others* [1990] 1 All ER 873 the court had approved the acceptance of the definition of passing off in *Erven Warnink BV v. J Townend & Sons (Hull)* [1979] 2 All ER 927 which had opined:

> ... Lord Diplock after pointing out the misrepresentation of one's goods or someone else was a species of wrong included in a wider genus rather than a separate genus, set out five essential characteristics of a passing off action in the following manner:
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> My Lords, *A.G Spalding & Ors v. A.W Gamage Ltd* and the later cases make it possible to identify five characteristics which must be present in order to create a valid cause of action for passing off: (I) a **misrepresentation** (2) made by a trader in the cause of trade, (3) to prospective customers of his or ultimate consumer of goods or

A services supplied by him, (4) which is calculated to injure the business or goodwill of another trade (in the sense that this is a reasonably foreseeable consequence) and (5) which cause actual damage to a business or goodwill of the trader by whom the action is brought or (in a *quia timet* action) will probably do so (emphasis added).

B **[25]** In fact the plaintiff in its submission canvassed exactly the same ingredients as found in all the above cases, and especially clear was that, *confusion* was never part of one of the characteristics of passing off. In other words, a distinction must be made out between the requirements of passing off and the ingredient as spelt out in the Trade Marks Act C 1976. Having considered the *locus classicus* cases in the like of the above cases eg, *Seet Chuan Seng v. Tee Yih Jia Foods Manufacturing Pte Ltd (supra)*, courts have consistently required the ingredient of *misrepresentation,* aside from the other ingredients, but never extending it to *confusion.* To acquiesce to the plaintiff's suggestion that passing off D has been established, merely because of some customer having suffered confusion by the catchy word, is extending unnecessarily the impugned common-law right of action. The act of any defendant is to cause damage to the plaintiff by the impugned deceit but never per se confuse the public. Needles to say, the outcome will certainly be different, in that there will be misrepresentation if the defendant is found for a fact to E have used the same or identical words and trade marks in the set up, in relation to identical goods *(H&R Johnson Tiles Ltd & Anor v. H&R Johnson (M) Bhd* [1998] 3 CLJ Supp 441 HC; *White Hudson & Co v. Asian Organisation Ltd* [1965] 31 MLJ 186).

F **[26]** In the course of the submission, both parties had concentrated much time on the poser whether the words Sure Catch are mere descriptive and generic terms, or fanciful words having a secondary meaning. To elucidate the latter statement, if a product were to have words like, "It is sweeter", "It will go faster", "It will supply energy" G and the like, such words merely explain the benefits that may be derived of the products. Nobody in his right frame of mind will endorse that those words have acquired a secondary meaning deserving protection. As opposed to them, descriptive words like "Dutch Baby" (milk), "Finger Licking Good" (chicken), "Ladies Choice" (butter), "Best Knife Cooking Oil" have attained a secondary meaning. More often than not the average H shopper will recognise those fanciful marks, due to their entrenched goodwill, and indeed will be accorded the necessary legal protection. If not for the attainment of secondary meaning, distinctive to the owners of the products, those words would remain uninspiring run of the mill descriptive or generic words not deserving of protection.

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[27] Linguistically speaking, if not for the assertion of the plaintiff, the words in relation to fishing equipments here are descriptive in nature intending to denote a certainty of a successful outing. As such, words that are used commonly outside, and not within the capacity of the secondary effect of the plaintiff's products, are thus not protected by law. The plaintiff naturally rejected that approach and had, not unexpectedly, ventilated that Sure Catch already had attained a secondary meaning and entitled to protection.

[28] Currently there are precedents which establish that in the absence of fraud, where descriptive words are used in a trade name, a small differentiation will suffice to defeat a plaintiff's claim of passing off. In the case of *Office Cleaning Services Ltd v. Westminster Window and General Cleaners, Ltd* [1946] Vol. 174 LT 229, the appellants ie, Office Cleaning Services, Ltd were incorporated in 1930 to carry on the business of the daily cleaning of offices. The respondent's company ie, *Westminster* Window and General Cleaners, Ltd was formed to take over a window cleaning business. From 1932 onwards the respondent did a regular business in cleaning offices under the style of Westminster Office Cleaning Association. In May 1942 the respondent advertised its business but had dropped the word *Westminster,* thus now running a business in the style of Office Cleaning Association.

[29] The appellants thereafter action sought an injunction to restrain the respondent from using, in connection with their business as contractors for the cleaning of offices, the trading style of the said Office Cleaning Association, or any style so closely resembling the appellants' as to be calculated to lead to the respondent's business being confused with that of the appellant. For comparison purposes I reproduce the names of the two protagonists:

1. appellant - Office Cleaning Services, Ltd; and

2. respondent - Office Cleaning Association

[30] Only a thin line separated them, namely Services and Association. As for the rest of the descriptive words the similarity was quite obvious. Despite that obviousness, the court had held that the use of the name Office Cleaning Association was not calculated to lead to the belief that the respondent's business was the business of the appellants. The appeal thus was dismissed. The House of Lords, as per the judgment of Lord Wright in no uncertain term had opined that in the absence of fraud where descriptive words were used in a trade name, a small differentiation would defeat a plaintiff's claim.

[31] Christopher Wadlow in *"The Law of Passing-off,* 2nd edn at p. 383 as regards the above case, in succinct terms had authored:

A There is a rule of law that relatively minor differences will suffice to distinguish the defendant's goods or business when both use a mark which is descriptive of the goods or services they provide. This applies even though the defendant is using the closely similar term in a trade mark sense. Office Cleaning Association was sufficiently different to Office Cleaning Services even though it was the trading name of the B defendant.

[32] To conclude on the facts, having sifted the evidence and without the necessity of minutely examining the offending products which carry the words Sure Catch, I find them to be different, absolutely neutral and C ineffective to deceive the non-discerning and ordinary shopper. I am unable to say in the circumstances of the case that the words Sure Catch can be equated in their effect with SureCatch especially when the differentiation is too obvious and not merely slight. Grammatically speaking the word SureCatch does not even exist in any English dictionary. Not only are the defendant's words positioned and arranged D in an unfanciful manner, the packaging differs in quality, colour attractiveness wanting, dominance being focused on the eagle and the encircled orange coloured background, and the words appear too generic. Advertence to the other markings and get up to assist me in my eventual finding of the differentiation is not improper or disallowed by E any principles of law. In the above case of *Colgate Palmolive Ltd & Another v. Pattron* [1978] RPC 635, the Court of Appeal later affirmed by the Privy Council, had not hesitated to be influenced by the mark, name and get-up used by the defendant in their deliberation.

F **[33]** In a gist, in the current case the focus is never on the two words, which are near invisible to the ordinary buyer, but to the other marks. At best he may fall prey to indecisiveness whether to buy or not, even if by chance he has the briefest of recollection of the plaintiff's product. If he is merely confused per se by reason of the generic words and it stops at that that is of no help to the plaintiff. G

[34] Therefore alluding to all the hypothetical examples for the purpose of analogy, read together with the available evidence, and risking repetition so as to avoid any misapprehension of my stance, I certainly am not persuaded that an ordinary average shopper, shopping at the H place where the products are sold will be deceived. An infringement of the right of property, upon which the plaintiff found its action, founded on the generic words calculated to deceive the customer, thus has not prevailed (*Boh Plantations Sdn Bhd v. Gui Nee Chuan & Ors* [1975] 2 MLJ 213). With such a failure it must inevitably mean that the injunction I application has to be rejected too.

[35] Perhaps it is not too late to mention the issue of damages, which is an essential element of this cause of action. Where the similarities are quite obvious (which is not the case here), I can likewise readily infer the likelihood of damages and loss to the respondent's goodwill. Unfortunately the very evidence of the plaintiff in encl. 3 shows that the plaintiff's business has not lost out but has improved with each succeeding year. Paragraph 14 supplies the following figures:

Year	**Gross Sale (RM)**
March 1998-Feb 1999	1,302,494.06
March 1999-Feb 2000	2,304,389.05
March 2000-Feb 2001	3,769,903.69
March 2001-Feb 2002	2,465,649.91
March 2002-Dis 2002	2,157,248.29
January 2003-Sep 2003	3,101,515.27

[36] As opined in the case of *Seet Chuan Seng v. Tee Yih Jia (supra)* the plaintiff must establish that it has suffered damages. Certainly the plaintiff has failed to do that and by its very own evidence has caused the opposite to be proved instead.

[37] Even if I were to err on the part of my failure to identify the existence of a serious question worthy of trial, the issue of whether on a balance of convenience the injunction ought to be granted pending the disposal of the substantive hearing, is another matter which requires different consideration. To eliminate the issue of compensation for my consideration, I need to state that I am convinced of the plaintiff's ability to fulfill that part of the undertaking requirement. But that is only a small part of the overall consideration. As regards the justice of the matter, what swayed me not to be too hasty in granting the injunction, even if I were to have erred on the "serious question factor", was the reasonably foreseeable debilitating effect on the defendant's business if it was prevented from carrying on business as usual. I could foresee all the early hard work in the like of goodwill, clientele connection etc. being destroyed beyond redemption by that interim injunction, followed in its wake by unemployment and social problems in the defendant's set-up. No amount of compensation can possibly spare the defendant or any aggrieved person of such agony at that late stage through effluxion of time *(American Cynamid Co. v. Ethicon Ltd* [1975] AC 396; *Keet Gerald Francis Noel John v. Mohd Noor bin Abdullah* [1995] 1 CLJ 293 CA).

A **[38]** Having taken all the practical realities into consideration, and having weighed the harm the injunction will generate, conditional on the hypotheses that a serious question does exist, I must reject the defendant's application with costs. This conclusion is aside from my earlier finding that a passing off had not been successfully established
B by the plaintiff. That being so *status quo* must remain.

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